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OFFICE OF PETITIONS

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|-------------------------------|---|------------------------------|
| In re Application of | : | |
| David FIKSTAD et al. | : | |
| Application No. 10/764,016 | : | DECISION DISMISSING PETITION |
| Filed: January 23, 2004 | : | UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No. 23625.CON | : | |

This is a decision on the petition under 37 CFR 1.78(a)(3), filed October 3, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of prior-filed nonprovisional applications set forth in the concurrently filed amendment.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The amendment submitted concurrently with the petition as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in

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a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

It is further noted that a petition filed under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of prior-filed nonprovisional applications as set forth in the concurrently filed amendment cannot be granted until a grantable petition under 37 CFR 1.78(a)(3) is filed in parent Application No. 10/700,838 establishing the requested chain of continuity.

In view of the above, the petition is **DISMISSED**.

Before the petition can be granted, petitioner must submit a substitute amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3).¹

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
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 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to David Bucci at (571) 272-7099.




Brian Hearn
Petitions Examiner
Office of Petitions

¹ The claim for priority may also be made in an Application Data Sheet in compliance with 37 CFR 1.121 and 37 CFR 1.76(b)(5).

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Patent App. SN: 10/764,016
Attorney Docket No. 23625.CON**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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|--------------------|--|--|
| APPLICANT: | Fikstad et al. | CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8 I hereby certify under 37 CFR § 1.8 that this correspondence is being facsimile transmitted to the USPTO or being deposited with the United States Postal Service with sufficient postage as first class postage in an envelope addressed to Commissioner of Patents Alexandria, VA 22313 on the date indicated below.  Judy Anderson <u>10/3/2005</u> Date of Deposit |
| SERIAL NO.: | 10/764,016 | |
| FILED: | January 23, 2004 | |
| FOR: | PHARMACEUTICAL COMPOSITIONS WITH SYNCHRONIZED SOLUBILIZER RELEASE | |
| ART UNIT: | 1614 | |
| EXAMINER: | Royds, L. | |
| DOCKET NO.: | 23625.CON | |

**PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM FOR THE
BENEFIT OF A PRIOR-FILED APPLICATION UNDER 37 C.F.R. § 1.78(a)(3)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a petition to correct a claim for the benefit of a prior-filed patent application pursuant to 37 C.F.R. 1.78(a)(3), and in accordance with the fees set forth in 37 C.F.R. 1.17(t).

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